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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/609,187	06/26/2003	Mark Lee Kenworthy	3382-64489	7623
26119 7590 02/07/2007 KLARQUIST SPARKMAN LLP 121 S.W. SALMON STREET SUITE 1600 PORTLAND, OR 97204			EXAMINER CHERRY, STEPHEN J	
			ART UNIT	PAPER NUMBER
			2863	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/07/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/609,187

Applicant(s)

KENWORTHY, MARK LEE

Examiner

Stephen J. Cherry

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17, 30-40, 46 and 47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17, 30-40, 46 and 47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u>                                    | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :10-26-2005, 9-19-2005, 6-29-2005.

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of invention 1, claims 1-17, 30-40, 46 and 47 in the reply filed on 10-27-2007 is acknowledged.

### ***Specification***

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because the legal phraseology, "comprises" should be avoided. Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-17, and 30-40 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims recite methods and

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computer readable medium for determining a capability rating for a system; however, the claimed inventions produce no tangible result, such as displaying the information, or communicating the information to an operator. Therefore, the claims are drawn to non-statutory subject matter.

Claims 46 and 47 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are drawn to software systems. Computer software claimed without a computer readable medium is considered to be functional descriptive material, which is non-statutory. (see MPEP 2106.)

For further guidance, please see the following OG announcement:

<http://www.uspto.gov/web/offices/com/sol/og/2005/week47/patgupa.htm>

### ***Allowable Subject Matter***

Claims 1-17, 30-40, and 46-47 are rejected under 35 U.S.C. 101, but would be allowable if rewritten to include all the present subject matter, and to overcome this rejection.

The following is a statement of reasons for the indication of allowable subject matter:

Claim 1 recites, "comparing the set of computer system features and the performance results with capability rating requirements, wherein the capability rating requirements comprise a required set of features and required performance criteria;

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and determining a capability rating for the computer system based on the comparing". This feature, in combination with remaining claimed structure, overcomes the prior art of record.

Claim 30 recites, "comparing the set of computer hardware component features and the performance results with capability rating requirements; and determining a capability rating for the computer hardware component based on the comparing". This feature, in combination with remaining claimed structure, overcomes the prior art of record.

Claim 46 recites, "means for comparing the set of computer system features and the performance results with capability rating level requirements; and means for determining a capability rating level for the computer system based on the comparing". This feature, in combination with remaining claimed structure, overcomes the prior art of record.

Claim 47 recites, "means for comparing the set of computer hardware component features and the performance results with capability rating level requirements; and means for determining a capability rating level for the computer hardware component based on the comparing". This feature, in combination with remaining claimed structure, overcomes the prior art of record.

U.S. Patent 6,487,522 determines computer inventory of installed components, but does not test performance.

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"EA's Westwood Studios Teams with NVIDIA and Madonion.com" discloses scanning attributes, but does not disclose testing performance to determine if a computer meets minimum requirements.

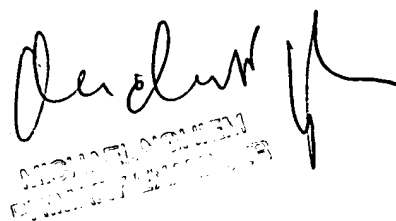
**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen J. Cherry whose telephone number is (571) 272-2272. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow can be reached on (571) 272-2269. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SJC



A handwritten signature, likely of Stephen J. Cherry, is written over a rectangular USPTO stamp. The stamp contains the text "RECEIVED", "JUL 10 2010", and "COMMUNICATIONS SECTION".

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